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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,561	01/17/2001	Kareem I. Batarseh	3731-002	5927

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,561	Applicant(s) BATARSEH ET AL.	
	Examiner Frank I Choi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1-4,7-16,18-27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/3/2004 has been entered.

Claim Objections

Claims 24,25,27 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to the other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4,7-16,18-27,29,30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for metal amino complexes which can be formed at a pH of 2 or less, does not reasonably provide enablement for amino acids which do not form a complex at pH 2 or less. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The nature of the invention:

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The invention is directed to a complex of amino acid and metal which is prepared at pH of less than about 2 or less or 2 or less.

The state of the prior art and the predictability or lack thereof in the art:

The prior art of record appear to disclose some amino acids that complex with metals at a pH of about 2. Applicant has argued to the contrary and has argued that the prior art shows that methionine forms complexes at pH 4 and above and glycine and aspartic only forms basic solutions at a pH greater than 6.5. As such, predictability in the art appears to be low.

The amount of direction or guidance present and the presence or absence of working examples:

The Specification indicates that the preparation can be performed at a pH of about 2 or less, however, the working examples do not indicate the pH of the process.

The breadth of the claims and the quantity of experimentation needed:

The claims are broad in that they claim amino acids in general. The specification defines amino acids as including methionine, glycine and aspartic acid (Specification, pg. 7). As such, in light of the fact that Applicant is claiming amino acids which it has argued cannot form complexes at the claimed pHs, it appears that one of ordinary skill in the art would be required to do undue experimentation in order to determine what amino acids will form complexes at pHs of about 2 or less.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2,12-16,18-28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that the claims fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 12 filed 4/4/2003. In that paper, applicant has stated that the product of the claimed invention is in a solid state and that in an experiment when glutamic acid was added to solution a yellowish precipitate was formed, and these statements indicate that the invention is different from what is defined in the claim(s) because the claims do not require that the product be solid and in fact claims aqueous solutions. Applicant argues that one skilled in the art would know that a DSC spectrum is used for analyzing solids not liquids. This is incorrect. A DSC spectrum can analyze solids and liquids (See http://www.tribiologytesting.com/more_test.htm). Examiner cites to Specification at Page 11, lines 21-page 17, line 5 as evidence that the complex is in solid state in the formulation. However, the cited passage in the Specification appear to discuss aqueous solutions but does not appear to indicate that the complexes are solid in the same.

Claim Rejections - 35 USC § 102/103

Examiner notes that any rejection recited below is not intended to apply to subject matter which was allowed and issued as U.S. Pat. 6,242,009.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Poddymov et al. (1977) or Sanchez et al. (1981) (English translations of each) for the reasons of record set forth in the prior Office Actions and the further reasons below.

Poddymov et al. or Sanchez et al. teach method of chelating silver with amino acids in acidic conditions at room temperature (See entire documents).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and use that contain the same exact ingredients/components as that of the claimed invention. See *In re May*, 197 USPQ 601, 607 (CCPA 1978). See also *Ex parte Novitski*, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

In response to applicant's argument that Poddymov et al. or Sanchez et al. do not teach or suggest that these complexes are to be used as bactericides, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136

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USPQ 458, 459 (CCPA 1963). Claim 13 does not recite that the formulation contains a disinfectant which is different from the complex and still recites a pH of about 2 or less. The Poddymov et al. reference discloses that complexes are formed at a pH of less than 3. Applicant has not shown that a pH of about 2 excludes a pH of 3 or less. Applicant reminds Applicant that the Graham v. John Deere factors are not applicable in an inherence rejection under 102/103. Notwithstanding the teachings in Poddymov et al. relative to formulation of complexes at higher pHs, the fact remains that the prior art discloses methods in which were performed at a pH of about 2 or less and complexes were formed. Applicant does not show how the replacement of protons by the metal makes the product in Sanchez different from the claimed invention.

Conclusion

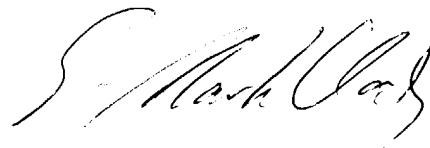
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

August 23, 2004



S. MARK CLARDY
PATENT EXAMINER
GROUP 1200

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